

Remarks

35 U.S.C. § 103 Rejection of Claims

In the 3 May 2006 Office Action, claims 34 - 52 and 62 - 134 are rejected as being unpatentable over U.S. Patent 6,332,163 (hereinafter, Bowman-Amuah) in view of U.S. Patent 6,301,584 (hereinafter, Ranger).

The Assignee respectfully traverses the § 103 rejections of claims 34 - 52 and 62 - 134 in four ways. First, by noting that the Office Action cites a combination of documents that teaches away from the proposed, theoretical combination. Second, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. Third, by noting that the cited combination of documents fails to make the invention as a whole obvious. Fourth, by noting that the Examiner has not identified how the cited combination of documents could be combined to produce anything useful. The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 3 May 2006 Office Action for claims 34 - 52 and 62 - 134 can be traversed.

As discussed previously, the references cited in the 3 May 2006 Office Action teach away from the theoretical combination used to support the rejections of claim 34 - 52 and 62 - 134. MPEP § 2145 X.D.2 provides that: "it is improper to combine references where the references teach away from their combination." As detailed below, the two references teach away from the theoretical combination suggested by the Examiner in at least 3 ways. Bowman-Amuah is an invention for:

"implementing communication services patterns. A fixed format stream-based communication system is provided and service is delivered via a globally addressable interface. Access is afforded to a legacy system. Service is delivered via a locally addressable interface....(portion omitted by Assignee) and data is efficiently retrieved (Bowman-Amuah, abstract).

At the same time, Ranger is a:

data integration system and method gathers information dynamically from one or more data sources, which may be located at different servers and have incompatible formats, structures the information into a configurable object oriented information model and outputs the information for the user according to an associated, configurable visual representation with automatic content classification (Ranger, abstract).

As mentioned in the abstract, the Bowman-Amuah invention already incorporates a number of different methods for efficiently retrieving and managing the data required to support

communication patterns. These methods include: the use of data handlers to manage the retrieval and storage of data from databases (Bowman-Amuah C280, L64 – C283, L67) and the development of data access objects that encapsulate the rules for data access so as to keep them separate from business logic (Bowman-Amuah C285 L 35). In the Bowman-Amuah invention, business objects use the data access objects to obtain the required data as required for completion of their tasks. At the same time, the Ranger method invokes agents to gather data, post the results of their data gathering on to a common “blackboard” before integrating the data into one or more entities. Put another way, the Bowman-Amuah invention combines the access to data with the execution of business object functionality. In fact, it is a specific goal of Bowman-Amuah to couple the access to data with the completion of business functions (Bowman-Amuah C284, L6 – 7). By way of contrast, the Ranger invention separates the aggregation of data into a completely separate, time consuming function. Given the above discussion, it is clear that the two inventions teach away from the theoretical combination. As mentioned in the abstract the Bowman-Amuah supports stream based communications (C283, L4), this also teaches away from a combination with Ranger because the Ranger methodology would not support the speeds required to support streaming communications. Finally, the third way Bowman-Amuah teaches away from a combination with Ranger is that Bowman-Amuah teaches that xml is useful only for web data management and not for enterprise data management (C40, L65 – C41, L5).

As discussed previously, the 3 May 2006 Office Action fails to establish the prima facie case of obviousness required to sustain the rejections of claim 34 - 52 and 62 - 134. MPEP 2142 provides that: in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. As detailed below, the 3 May 2006 Office Action fails to meet all three of the criteria for establishing a prima facie case of obviousness for 34 - 52 and 62 - 134.

The 3 May 2006 Office Action fails to meet the first criteria for establishing a prima facie case of obviousness for claims 34 - 52 and 62 - 134 because it does not provide any meaningful evidence indicating that there was any suggestion, teaching or motivation (including scientific reasoning) in the prior art to modify or combine the teachings of Bowman-Amuah and Ranger. In fact the opposite is true as the Bowman-Amuah and

Ranger specifications make it clear that there is an incentive not to complete the theoretical combination contained in the Office Action. It is well established that “teachings of references can be combined only if there is some suggestion or incentive to do so” quoting ACS Hosp. Sys., Inc. v Montefiore Hosp., 732 F.2d 1572, 1577 221 U.S.P.Q 929,933 (Fed. Cir. 1984). Reasons for not completing the proposed theoretical combination that are taught by the cited documents include:

1. the Bowman-Amuah method already has a number of mechanisms for efficiently retrieving data and there is no need for another method like that disclosed by Ranger to be added to the mix;
2. the Bowman-Amuah method teaches the importance of a tight coupling of data access with the completion of business processing while the Ranger method teaches a stand alone method for data access; and
3. the Ranger method could not support the data access speeds required to support the streaming communication patterns supported by the Bowman-Amuah invention.

The 3 May 2006 Office Action fails to meet the second criteria for establishing a prima facie case of obviousness for claims 34 - 52 and 62 - 134 because it does not cite a combination of documents that has a reasonable expectation of success. One of the primary reason for this is that the Ranger method could not support the data access speeds required to support the streaming communication patterns supported by the Bowman-Amuah invention (for example, see FIG 20, Bowman-Amuah – real time data stream).

As noted previously, The 3 May 2006 Office Action also fails to meet the third criteria for establishing a prima facie case of obviousness. The cited theoretical combination fails the third criteria because it does not teach or suggest one or more limitation for every claim (34 - 52 and 62 - 134). Limitations not taught by the theoretical combination include: integrating data from a variety of systems using xml and a common schema, value chain organizations, elements of value, units of measure, etc.

Far from establishing a prima facie case of obviousness for claims 34 - 52 and 62 - 134, the cited combination of documents in the 3 May 2006 Office Action provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. It does this by calling for a combination of documents when the cited documents teach that there is an incentive not to make the theoretical combination, by

advocating a combination of documents that is an almost certain failure and by relying on a combination of documents that fails to suggest one or more limitations for every claim.

As discussed previously, the third way the rejection of claims 34 - 52 and 62 – 134 contained in the 3 May 2006 Office Action will be traversed is by noting that the cited combination of references fails to make the invention as a whole obvious as required by MPEP 2141.02 which states that:

In determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious.

As noted previously, the obviousness rejections are based on combinations of Bowman-Amuah and Ranger. Bowman-Amuah teaches a method for implementing communication service patterns that incorporates a number of methods for accessing data to support the implementation of these patterns. These methods teach away from the claimed methods and from a combination with Ranger. Bowman-Amuah also teaches that xml is only useful for web data management and that xml is going to be displaced in this area by smil. As noted previously, Ranger teaches a method for integrating data and configuring visual representations that teaches away from the claimed methods and from a combination with Bowman-Amuah. As noted below, the Examiner has not detailed how these different teachings are supposed to be combined and the Assignee is not aware of any way in which they can be combined to replicate the functionality of a single claim for the above referenced application. Taken together the cited combination of documents fails to make the invention as a whole obvious. The cited combination of documents also fails to make a single aspect of the claimed invention obvious.

As discussed previously, the fourth way the rejection of claims 34 - 52 and 62 – 134 contained in the 3 May 2006 Office Action will be traversed is by noting that the 3 May 2006 Office Action does not teach how an invention for implementing communication services patterns and an invention for integrating data and configuring visual representations could be combined to produce anything useful. It is well established that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In spite of this well know requirement, the Office Action has not described how the teachings of these references

would be combined or the reason for doing so. Furthermore, as detailed above, the reference teachings make it obvious that the cited combination should not be made and that once made it could not reasonably be expected to produce anything useful.

The Assignee also notes again that there are still other ways in which all § 103 obviousness rejections in the 3 May 2006 Office Action for claims 34 - 52 and 62 - 134 can be traversed. For example, it is likely that a combination of Ranger and Bowman-Amuah would destroy the ability of the Bowman-Amuah invention to function. It is also important to note that even if the documents didn't teach that there are a number of reasons not to complete the theoretical combination proposed by the Examiner, the combination of documents do not provide the teachings required to replicate a single claim.

Information Disclosure Statements

The Assignee notes that once again the Examiner has again failed to return an initialed copy of the previously provided Information Disclosure Statements indicating that the Examiner has reviewed the previously provided documentation. The Assignee notes that the Examiner has previously acknowledged reviewing the same references for other cross referenced applications and requests again that the Examiner return said documents to the Assignee as soon as possible.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that "in amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections." The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the prior set of claims were amended and/or cancelled was to narrow the issues for appeal and put the application in a form for issue and allowance by fixing inadvertent clerical errors. Support for the new claims, 135 – 167, can be found in the paragraphs 47 – 128 in the specification and FIG. 5A – 5F.

Reservation of Rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification. Several continuations to the above referenced application are being prepared and/or have already been submitted and the claims in the new applications and/or in other cross-referenced applications are expected to cover the subject matter of all previously cancelled claims in addition to covering the additional subject matter required to fully describe the novelty of the disclosed invention.

Summary/Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,



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